

REMARKS/ARGUMENTS

1. New claims 11 – 19 have been added to particularly point out and distinctly claim the subject matter applicant regards as his invention and to  
5 overcome the objections set forth in the above-cited Examiner's Office Action.
2. The Examiner cited the Mizialko patent (U.S. patent 5,325,994), the Baehr patent (U.S. patent 1,543,086), and the Dillingham patent (U.S. patent 6,439,806 B1) in combination as rendering original claims 1 – 10 obvious and therefore unpatentable with respect to the cited references.
- 10 3. The Baehr reference discloses a glue pot that includes an inner glue containing vessel 16 disposed within an outer vessel 1. Sufficient space is provided between the vessel 16 and vessel 1 to allow for the circulation of heated water that heats the glue held within vessel 16 with the water 2 directly contacting the glue containing vessel 16. The outer vessel 1 is secured to a  
15 base by screws 11, and the glue containing vessel 16 is secured to the outer vessel 1 by a bayonet lock interconnection that includes lugs and an annular, integral flange 19. The thermostatic control for temperature control comprises upper and lower contact members 32 and 33 having free ends and with the movable free end of the upper member 32 responsive to the heat conditions at  
20 the lower end of the outer vessel 1 for opening and closing the electrical circuit. The heating element itself consists of several layers of materials that are pressed into heat conducting engagement with the bottom 4 of the outer vessel 1 (lines 115 – 121).

4. The Mizialko reference discloses an apparatus for dispensing flowable material and includes a square-shaped holding vessel 12 within which a second containment chamber is permanently secured and enclosed. A burner element 24 located beneath and in contact with the floor 98 of the inner 5 containment chamber (see, for example, figure 3 and column 7, lines 1 - 5) heats flowable material held within the inner containment chamber to the desired temperature whereupon the flowable material is dispensed from a pour spout 28 located at the bottom of the vessel 12 for repairing and filling cracks, fissures, and channels. The inner containment chamber is defined by walls 14 10 and 16 that are permanently fixed to vessel 12; and thus the apparatus can only be utilized on those locations that can support and accommodate the entire apparatus 10.

5. The Dillingham reference discloses a pavement repair material cart that includes a portable cart 11 having a platform for supporting a propane tank 27 15 and an insulated heating chamber 13. Permanently disposed within the insulated chamber 13 is a containment chamber 59 that slopes and narrows downwardly to opening 67 through which the heated/melted material is dispensed (column 5, lines 1 – 5). The portable cart 11 is used exclusively for repairing cracks and channels in roadways.

20 6. The ability to modify or combine references does not make the combination or modification obvious, i.e., the mere fact that references may be modified or combined does not make the modification or combination obvious

unless the prior art suggests the desirability of the modification or combination.

In re Fritch 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

7. The Examiner cites the Mizialko and Dillingham references for the proposition that it would have been obvious to modify the apparatus of  
5 Mizialko to accommodate the temperature gauge of Dillingham. However, new claims 11 – 19 do not recite this feature and Applicant therefore believes and argues that this objection has been rendered moot and should therefore be withdrawn.

8. In addition, the Examiner argued that it would have been obvious to  
10 modify the interior cooking vessel of Mizialko, presumably the structure defined by walls 14 and 16 and illustrated in figure 3, to accommodate the removable cooking vessel structure of Baehr, presumably the outer water containing vessel 1, to allow the user to gain access to the heating elements for inspection or repair.

15 Applicant first expresses his dismay that the Examiner did not refer to these structures by their element numbers so as to avoid any ambiguity in comprehending the Examiner's arguments. For example, in the Baehr reference, the outer cooking vessel 1 is secured to the base by screws 11, and the inner vessel 16 – which holds the heated glue - is removably attachable to  
20 the outer vessel 1 by the bayonet locking connections. Be that as it may, Applicant will proceed on the assumption the interior cooking vessel of Mizialko is the structure referred to by element numbers 14 and 16, and that the removable cooking vessel structure of Baehr is the outer vessel 1.

9. While a motivation to combine may be found in the prior art implicitly or explicitly, the showing of combinability must be clear and particular. *In re Dembiczak* 175 F.3D 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Nonetheless, there is no motivation to modify a prior art device if the 5 modification would render the device inoperable for its intended purpose. *McGinley v. Franklin Sports, Inc.* 262 F.3d 1339, 1354, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001).

Baehr discloses a glue pot that includes an outer vessel removably mounted to a base for cleaning and repairing the electrical circuitry and the 10 heating elements. The inner glue containing vessel 16 has a handle 24 for carrying the glue pot by hand to the application site. Mizialko's apparatus, in contradistinction, is intended for repairing cracks and fissures in asphalt, concrete, etc. that comprise sidewalks, roadways, and runways. The apparatus is wheeled above and along the cracks or fissures so that they can be filled by 15 flowable material dispensed from pour spout 28. The efficiency of the Mizialko apparatus is that the flowable material is automatically dispensed from the spout 28 and into the cracks and fissures as the individual pushes the apparatus therealong.

There would simply be no need to modify the inner containment 20 chamber of Mizialko as defined by walls 14 and 16 to incorporate the removable cocking vessel 1 of Baehr. The flowable material is poured into chamber 14 and 16 of Mizialko and dispensed through spout 28. Nothing in Mizialko suggests or teaches that the inner chamber 14 and 16 should be

capable of being lifted up out of the holding vessel 12 and manually carried to the application site. This modification would actually teach against the purpose of Mizialko's apparatus and would require considerable modification to achieve. The efficiency of Mizialko's apparatus is that flowable material is 5 automatically dispensed from spout 28 while the individual pushes the cart along the fissure or crack to be filled; nothing in Mizialko suggests, teaches, or discloses that the individual should carry a vessel holding the flowable material to the application site, and then dispense the flowable material on the crack or fissure by pouring the material out of the vessel or by using a brush to 10 apply the material to the crack or fissure.

10. In view of the above, Applicant believes that the combination of cited references cited by the Examiner are invalid as they teach away from Applicant's invention, and as the combination of the structure of the Baehr reference with the Mizialko reference renders the Mizialko apparatus 15 inoperable for its clearly intended purpose. Thus, new claims 11 – 19 specifically recite a portable apparatus wherein the heating element – the gas burner – is not in direct contact with the vessel – the tar cooking vessel – holding the material to be heated. Also, the cooking vessel is removably supportable on a cooking platform that itself can be removed from the 20 containment body. The combination of a heating element not in direct contact with a removable cooking vessel and a cooking vessel supported on a platform both of which are not in direct contact with a heating means – the gas burner – is not taught or disclosed in the references cited by the Examiner either singly

or in combination. Applicant believes new claims 11 – 19 are patentably distinguishable over the cited references, considered singly or in combination.

11. In view of the above, Applicant respectfully requests allowance of new claims 11 – 19 and passage of the case to full issuance. In addition, no new 5 subject matter has been added, and this amendment has been prepared and submitted in a good faith effort to meet the Examiner's objections as stated in the above-identified Office Action.

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Respectfully submitted,

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Theresa M. Seal